

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 028622/0101

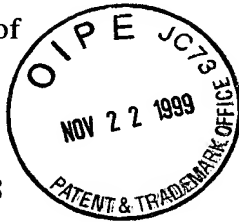
In re patent application of

DICKMANN *ET AL.*

Serial No. 08/981,583

Filed: February 3, 1998

For: IMMORTALIZED EPITHELIAL TUMOR CELL



Group Art Unit: 1642

Examiner: A. Harris

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

In response to the Office Action dated September 21, 1999, applicant hereby provisionally elects the claims of Group I, claims 1-12, 16-22, 29-31, 33 and 34 for prosecution in the subject application with traverse. Enclosed is a petition for a one-month extension of time to extend the time to respond to November 21, 1999, and the requisite fee. If the petition or fee is deficient or absent, please consider this paragraph a the request for the extension of time and an authorization to withdraw the appropriate fee under from Deposit Account No. 19-0741.

Pursuant to MPEP § 1850, in PCT national phase cases, (§371 cases) the Examiner is required to follow the determination of the International Bureau and cannot *sua sponte*, set forth his or her own groupings for purposes of examination. For example, *Caterpillar Tractor Co. v Commissioner of Patents*, 650 F.Supp. 218, 231 USPQ 590 (VA 1986). In this regard, the examiner has not even provided a reasoned explanation as to why the purported claim groupings fail to comply with the PCT rules. It is noted that the International Searching Authority did not find a lack of unity of invention.

The standards of restriction practice for PCT applications entering the national stage in the United States Patent & Trademark Office, as is the present application, are governed by 37 CFR §§ 1.475 and 1.499. The present application contains claims to all three categories of product, process of making and process of use, and pursuant to 37 CFR §

1.475 (b), an international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:...(3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product;..." This category applies to the present application, and in view of this patent rule, it is requested that claim 35 to the extent that it is directed to a method of using a pharmaceutical composition containing the epithelial tumor cell be included with the claims of Group I and examined on the merits.

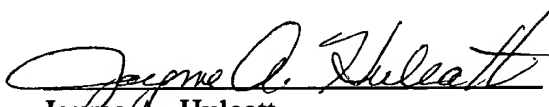
Applicants, of course, reserve the right to file one or more divisional applications covering the subject matter of the non-elected claims.

Receipt of the initial Office Action on the merits is awaited.

Respectfully submitted,

November 22, 1999

Date


Jayne A. Huleatt
Registration No. 34,485

Foley & Lardner
3000 K Street, N.W.
Suite 500
Washington, D. C. 20007-5109
(202) 672-5300